

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:
Banerjee et al.

Serial No.: 09/904,734

Confirmation No.: 3372

Filed: July 13, 2001

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Group Art Unit: 2176

Examiner: Paul H. Nguyen-Ba

For: METHOD AND SYSTEM FOR ASCERTAINING CODE SETS ASSOCIATED
WITH REQUESTS AND RESPONSES IN MULTI-LINGUAL DISTRIBUTED
ENVIRONMENTS

MAIL STOP APPEAL BRIEF - PATENTS
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CERTIFICATE OF TRANSMISSION

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November 5, 2007 / Joseph Jong/
Date Joseph Jong

REQUEST FOR REHEARING

Dear Sir:

Applicants submit this Request for Rehearing to the Board of Patent Appeals and Interferences regarding the Board Decision in this matter dated September 5, 2007. Pursuant to 37 CFR 41.52, reconsideration of the split decision of the Board to uphold the rejection of claims 1 – 27 is requested. This Request for Rehearing is believed to be timely since facsimile transmitted within two months of the date of the original decision of the Board. Please charge any necessary fees for filing this Request for Rehearing to Deposit Account No. 09-0465/ROC920010101US1.

ARGUMENTS

In upholding the rejection of claims 1-27, two members of the Board rely on an assertion that Applicants' specification demonstrates that the claimed subject matter was known in the art. Specifically, the majority decision provides:

We direct attention to Appellants' Specification which appears to admit that all features of claim 12 were known in the art at the time the invention was made. Appellants admit that the HTTP specification contains an optional header that may contain character set information (Specification ¶ 8). While the use of this header by a client is optional, a fully compliant HTTP server receiving an HTTP request must still determine if a request header (the Content-type header) composed according to a network communication protocol (HTTP) received with a client request from the at least one client computer designates a character set (Specification, ¶ 9). Appellants also admit that, upon determining that the client request does not designate a character set, a well known API, developed by Sun Microsystems, may be invoked to retrieve locale information from the client request in order to determine an associated character set (Specification, ¶ 35). In the context of these admissions, it is implicit to translate server locales to a character set, particularly in view of the recognition in paragraph 9 of the Specification that it is known to select a character set when the Content-type header fails to specify a character set.

Board Decision, pp. 5-6. Respectfully, Applicants submit that the Board Majority is misinterprets Applicants' general description of the HTTP specification and technology created by Sun Microsystems to conclude that this technology discloses the particular, specific limitations of the present claims. Applicants do not admit to the Sun Microsystems' API as teaching the limitations of claim 12 as suggested by the Board, nor does the Applicants' specification support such an admission. Set out in full, paragraph 35 provides:

If the "Content-Type" header is missing from an HTTP request, or if the "Content-type" header does not contain a code-set identifier, the computer program 110 determines the locale of the HTTP request by invoking an Application Programming Interface (API) 129 configured to extract the locale from the HTTP request. One API which may be used to advantage is the ServletRequest.getLocale() API developed by Sun Microsystems. If the Accept-Language HTTP input header contains the most preferred cultural setting of the client, the API 129 returns that cultural preference. Otherwise, it returns the server's locale as the default. The computer

program 110 selects the appropriate character set associated with the locale identifier returned by the API 129.

Application, ¶ 35. As correctly pointed out by the dissenting member of the Board, however:

The only information in paragraph ¶ 35 that can be fairly treated as admitted prior art is the description of "ServletRequest.getLocale()" as an API that was developed by Sun Microsystems for the purpose of extracting the locale from an HTTP request. The admitted prior art does not include (a) using that API to extract the local if the "Content-type" header does not contain a code set identifier, as required by the claim, or (b) associating the thus extracted locale with a character set, as also required by the claim. Instead, paragraph 35 attributes the use of the API in this manner to Appellants' computer program 110.

Board Decision, pp. 8-9 (Martin, Dissenting) (emphasis added). In other words, the discussion of the ServletRequest.getLocale() in paragraph 35, and elsewhere in Applicants specification does not expressly (or inherently) disclose that this API call is configured to:

- if the request header does not designate the character set,
 - (i) retrieve locale information from the client request; and
 - (ii) associate the locale information with a character set,

as recited by claim 12. And in fact, paragraph 35 explicitly characterizes these operations as part of "computer program 110," i.e., as part of Applicants' invention, not as part of the Sun Microsystems API call, ServletRequest.getLocale().

Further, whatever mischaracterizations may have arisen from a reading of the Applicants' description in paragraph [0035] are ultimately resolvable by virtue of the fact that the Sun Microsystems API call (ServletRequest.getLocale()) is well-documented. A review of the relevant documentation available at [`http://java.sun.com/j2ee/1.4/docs/api/javax/servlet/ServletRequest.html#getLocale\(\)`](http://java.sun.com/j2ee/1.4/docs/api/javax/servlet/ServletRequest.html#getLocale()) reveals that the API returns the preferred Locale that the client will accept content in, based on the Accept-Language header. Thus, there is nothing noteworthy about this particular API relative to the limitations of claim 12. Instead, this particular API call may be useful, in some cases, for implementing an embodiment of Applicants' invention. Thus, the only "admission" made by the Applicants, is that the ServletRequest.getLocale() API call may be used to retrieve the preferred Locale that

the client will accept content in, based on the Accept-Language header. Applicants have not, and do not, admit that the ServletRequest.getLocale() API call performs the particular retrieving and associating functions, as recited by Claim 12.

Applicants also note that the Board's decision relies on a ground of rejection not raised by the Examiner during prosecution. Instead, during prosecution, the Examiner relied on *Veditz*, (U.S. 6,496,793) in a first non-final action and on *Veditz* and *Watanabe* (U.S. 6,185,729) in a subsequent non-final office action and final office action. Thus, if the Board maintains its decision to affirm the rejections on new grounds, Applicants respectfully request that the Board direct the Examiner to re-open prosecution to enter a rejection based on the Board's analysis, giving the Applicants a fair and reasonable chance to respond.

CONCLUSION

For all the reasons set forth above, Applicants respectfully request that the Board reconsider the Board Decision dated September 5, 2007. Alternatively, Applicants respectfully request the Board direct the Examiner to re-open prosecution and enter a new ground of rejection based on the Board's analysis.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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